

REMARKS

Amendments and Allowable Subject Matter

The claims are amended to correspond to the scope of allowable subject matter indicated on page 2 of the Office Action of March 28, 2005. Thus, claims 1, 30, and 46 are amended to recite that R₁ and R₂ are together an exocyclic methylene group, R₃ and R₄, independently of one another, mean a hydrogen atom or an alkyl group with 1 to 4 carbon atoms, and V and W together mean an E-double bond. Claims 5 and 21 are amended to be consistent with amended claim 1, and claims 20, 27, 37, 39, 49, and 50 are cancelled. Finally, claim 6 is amended to recite that in group Z' the optional keto groups and α - or β -hydroxyl groups are protected. See the description of Z' at the middle of page 35 of the specification.

These amendments are being made for purposes of furthering prosecution and are not to be construed as acquiescence to the Examiner's arguments concerning the election. Applicants reserve the right to file one or more divisional application directed to the cancelled subject matter. The compound claims now being clearly in condition for allowance, rejoinder of the method claims is respectfully requested pursuant to MPEP §821.04.

Examiner's Comments on Claim 6

At page 2 of the Office Action, the Examiner states that claim 6 does not define any method steps. This is incorrect as claim 6 clearly recites converting a compound of formula II into a compound of formula I by simultaneous or successive cleavage of the hydroxy and keto protective groups and optionally by partial or complete esterification of free hydroxyl groups.

The Examiner further asserts that method claims must recite how method steps are performed and specific reagents therefore. This is also incorrect. It is well settled law that it is a function of the specification, **not the claims**, to set forth reaction conditions and the like.

See, e.g., *Ex Parte Jackson*, 217 USPQ 804, 806 (POBA 1982), wherein the Board specifically stated:

It is by now well established that it is a function of the descriptive portion of the specification and not that of the claims to set forth operable proportions and similar process parameters and that claims are not rendered indefinite by the absence of the recitation of such limitations.

The specification clearly describes how to cleave protective groups and esterify free hydroxyl groups. See, e.g., page 36 of the specification.

In view of the above remarks, allowance of the instant application is respectfully requested.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,



Brian P. Heaney (Reg. No. 32,542)

Attorney for Applicant(s)

MILLEN, WHITE, ZELANO & BRANIGAN, P.C.

Arlington Courthouse Plaza I, Suite 1400

2200 Clarendon Boulevard

Arlington, Virginia 22201

(703) 812-5308 [Direct Dial]

(703) 243-6410 [Facsimile]

Internet Address: heaney@mwzb.com

Filed: May 26, 2005